

REMARKS

PENDING CLAIMS

Claims 1, 3-9 and 48-55 remain pending.

Rejections under 35 U.S.C. §103(a)

Claim 1, 3, 9 and 48-54 are rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0 131 277 in view of Yang et al. 6,042,754 and Martin et al. 5,649,410.

****Please note that Claims 1, 3, 9 and 48-54 were previously rejected under §103(a) in the Examiner Communication sent August 15, 2006 under a combination of the same three references listed above pursuant to the same reasoning presented in the current rejection. Subsequent to amendment and response by the Applicant, Examiner deemed these claims allowable in Examiner Communication sent February 16, 2007.****

The Examiner has withdrawn said allowability of all of the above listed claims in view of the same three references previously contemplated. For these reasons, Applicants initially direct their comments and traverse to the use of the '277 as a primary reference.

Primarily, MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Accordingly, the Examiner is required to show a motivation to combine these references. The '277 reference does not suggest a motivation to combine with references '754 and '410. The '277 reference, in fact, teaches away from the combination.

Specifically, the '277 reference is directed to polymerized film that is cut via stamping two components together. The stampable film is the exact weight that is needed for the final product. Hence, there is certainly no suggestion, nor a need to combine this with a reference like Yang, to achieve "having a variable volume between a first volume and a second volume, the second volume being greater than the first volume, wherein the mold parts have sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes from the mold cavity." Such a combination is improper according to MPEP section 2145 X.D.2. "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731.743, 218 USPQ 769,799 (Fed. Cir. 1983).

The Examiner has sought to combine the '277 reference with the '754 reference in each and every §103 rejection. Such combination is improper as there is no teaching or suggestion to combine, in light of the fact that the EP reference teaches away from a combination with '754.

Applicants further respectfully submit that a prima facial case of obviousness has not been established by the Examiner, because the '277 reference, alone or in combination with secondary references, does not disclose or suggest all of the limitations of the invention as currently claimed. The '277 reference discloses providing the blank with a thickness (i.e. length) of 0.1-1 mm and diameter of 9 mm, thus length/diameter ratio of 0.011-0.11. However, the '277 reference neither discloses, nor suggests, anything about increasing the length/diameter ratio to 0.2 to 5.0, which is specifically recited in Applicants' claim 1. Actually the '277 reference prefers to provide a blank with a thickness (i.e. length) of 0.15-0.4 mm and diameter of 9 mm, thus length/diameter ratio of 0.017-0.044 and **teaches away** from the currently amended claim 1. The '754 and '410 references are not able to fill the gap left by the '277 reference and should not be combined with the '277 patent for §103 obviousness rejection purposes.

For at least the reasons given above, Applicants respectfully submit that the teachings of EP 0 131 277 in view of Yang et al. 6,042,754 and Martin et al. 5,649,410 fail to disclose or suggest Applicants' invention as defined in claim 1. Claim 3, 9, and 48-54 and claim 55 are directly or indirectly dependent on from claim1. Accordingly, reconsideration of previous allowability and/or withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants believe that the claims, as presented, are in conditions for allowance.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

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